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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Olaf Hoffman, et al.**

Art Unit:

Serial No. **08/913,184**

International Appln. No.: **PCT/DE96/00457**

Filed: **05 March 1996**

For: **COMMUNICATION AND MEASUREMENT APPARATUS**

Hon. Assistant Commissioner of Patents

Attn: Legal Affairs Division

PCT Legal Office

Washington, DC 20231

**RECEIVED**

**15 FEB 2002**

Legal staff

International Division

Renewed Petition to Revive an Unintentionally Abandoned Application  
Pursuant to 37 C.F.R. 1.137(b)

Dear Sir:

Applicants hereby renew their petition to the Commissioner under 37 C.F.R. 1.137(b) for the revival of the subject application which was abandoned for unintentionally failing to respond to a Notice of Missing Parts.

Applicants hereby state that the entire delay in responding to the outstanding Notice of Missing Parts was unintentional in that Applicants' former law attorney has indicated that he never received the communication from the U.S. Patent and Trademark Office. (copy of letter attached). Applicants hereby state that the subject Renewed Petition is intended to encompass all delay attributable to Applicants, and that the entire delay from the due date for a reply until the filing of a grantable petition pursuant to this paragraph was unintentional.

Applicants specifically request that the subject application be revived for the purpose of responding to the outstanding Notice of Missing Parts, dated 12 March 1997.

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Certificate of Mailing Under 37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Assistant Commissioner for Patents, Washington DC 20231.

Date: 18 January 2002

Signature: Thomas F. Leichen

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Background

On 05 March 1996, applicants filed an international application PCT/DE96/00457 which claimed a priority date of 07 March 1995 and which designated the United States. On 12 September 1996, a copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB").

On 07 October 1996, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of the basic national fee was extended to expire 30 months from the priority date, i.e., 07 September 1997.

On 07 September 1997, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English. The transmittal letter noted that the international application had been transmitted by the IB.

On 03 December 1997, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 C.F.R. 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required. The Notification also informed applicants that the failure to submit these materials within one month of the date of the Notification would result in abandonment of the application.

On 16 July 1998, the DO/EO/US mailed a "Notification of Abandonment" (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a timely response to the Notice of Missing Requirements.

On 12 August 1998, applicants were notified by their outside counsel Mr. Richard Meyer of the Kenyon & Kenyon Law firm in New York City, NY, that he had received the above-noted "Notification of Abandonment", but had never received the above-mentioned "Notification of Missing Requirements". A copy of this communication is attached.

Applicants tried unsuccessfully several times to obtain help on this matter from the USPTO. Finally, Mr. Richard Lazarus advised that we should call Mr. Vincent Mellen, who proved to be quite helpful. 03 December 1998 Mr. Mellen returned my telephone call. He indicated that he would order the file and examine it to see if the "Notification of Missing Requirements" were actually mailed. On 10 December 1998, Mr. Mellen called the undersigned attorney and stated that the file indicates that the Notification had indeed been sent. In response to my request, Mr. Mellen then sent me a copy of the "Notification of Missing Requirements" by fax, so that I could respond to it.

On 16 December 1998, applicants attorney contacted our German Patent Associates, STRASSE & PARTNER and asked that they prepare the Declaration form and have the inventors (who reside in Germany) execute them. (Copy Attached) On 11 and 12 January 1999 the inventors executed it. The signed Declaration form was then forwarded to applicants' attorney on 25 January 1999, and received on 28 January 1999. (Copy of the cover letter attached)

On 12 February 1999, a Petition to Revive an Application Abandoned for Unintentional Delay, and a complete response to the Notification to File Missing Requirements was mailed to the USPTO by U.S. Express Mail. The attached copy of our post card indicates that the USPTO received the items in their mailroom on 16 February 1999.

On 06 August 2001, applicants filed a "Request For Status of Petition To Revive An Unintentionally Abandoned Application". It is clear from the recitation of facts on page 2 of the outstanding Decision On Petition, that the USPTO had totally lost the Petition filed on 12 February 1999.

Re The Discussion:

It is stated that the required reply was a proper response to the Notification of Missing Requirements, that is, a declaration in compliance with 37 C.F.R. 1.497 and payment of the \$130 surcharge for filing the declaration after the thirty month deadline. Applicant fully agrees.

Applicants submit that the response provided with the Petition on 12 February 1999 was full and complete. Applicant further submits that the conclusion reached in the Decision On Petition is not supported by the facts of the matter.

Point 1: The USPTO asserts that the Declaration was not included in the submission on 12 February 1999. The USPTO has no support for such an assertion because they clearly have lost the entire submission of 12 February 1999, and cannot reliably testify to any of its contents.

Point 2. The sole grounds for reaching the conclusion that the Declaration was not included was an examination of a copy of our postcard, stamped by the USPTO mailroom. On that postcard, the check box for "Declaration" was not checked. Applicants submit that the information on that card was misinterpreted by the board deciding the petition.

Applicants submit that the check box for "Declaration" is only checked for a submission of a declaration along with a new application. The postcard is clearly marked "(XX) RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION". As a matter of patent practice at applicants office, that legend is only added to a postcard when a complete response is attached.

Point 3. Reliance on applicant's postcard entry is misplaced. The postcard itself is not a required part of the response. Applicants submit that reliance should have been properly placed on the attorney's statement in the cover letter of the Response to Notice To File Missing Parts of Application, wherein the undersigned attorney positively states that "the missing Declaration, signed by the inventors and identifying this application by serial number and filing date, is submitted herewith".

Point 4. Mr. Gray's inquiry about the status of the Petition included a copy of the submission of 12 February 1999, copied from our file. That copy included the Declaration. To hold that the Declaration was missing from the original submission, yet present in the file copy submitted by Mr. Gray strains credulity.

Point 5. In the copy submitted with Mr. Gray's inquiry was a copy of the Transmittal form sent 12 February 1999. That form indicates that 12 pages were submitted. Page 1 is the Transmittal form itself. Page 2 is the Fee Transmittal form. Pages 3 and 4 are the Petition to Revive. Page 5 is a copy of the letter from Kenyon & Kenyon referred to above. Page 6 is a copy of the Notice of Abandonment. Page 7 is the cover letter for the Response to Notice of Missing Parts. Pages 8, 9, and 10 are copies of the Notification to File Missing Parts. Finally, pages 11, and 12 are the Declaration. If the Declaration were missing from the submission, the Transmittal letter would have listed 10 pages, not 12. That is, the Transmittal Letter is filled in after the pages of the submission are counted.

Summary: Applicants respectfully submit that the decision should have been made from the totality of the circumstances, and respectfully request reconsideration in light of all of the circumstances. That is,

- a. the fee for late submission of the declaration was paid;
- b. the declaration was signed on 11 and 12 January, in plenty of time to submit it on 12 February;
- c. it simply does not make sense to submit less than a complete response to a Notification of Missing Requirements;
- d. in the cover letter the undersigned attorney stated that the Declaration was submitted;
- e. the inquiry of Mr. Gray included a copy from the file, which copy included the declaration; and
- f. the inquiry of Mr. Gray included a copy from the file, which copy included a copy of the transmittal letter of 12 February indicating 12 pages were sent.

Applicants submit that a prima facia case has been made that the Declaration was indeed submitted on 12 February 1999, and that applicants statement regarding unintentional delay does therefore cover the entire period, including the period running from 16 February 1999 until 06 August 2001.

Additional Fees:

No additional fee is believed due. However, if an additional fee is due, please charge that fee to Deposit Account 20-0352.

Conclusion:

Applicants submit that the petition as submitted on 16 February 1999 is in a condition for granting, and such action is respectfully requested.

Applicants submit that the present showing establishes by a preponderance of the evidence that the declaration was submitted on 12 February 1999, and correction to that date is respectfully requested.

Respectfully submitted,  
Olaf Hoffman, et al.

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